

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-10 and 29-42 are currently pending. Claims 1, 7, 10 and 35 are independent. Claims 1 and 10 are hereby amended. No new matter has been introduced. Support for this amendment is provided throughout the Specification as originally filed.

Changes to the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. ALLOWABLE SUBJECT MATTER

Applicants thank the Examiner for noting that claims 7 and 35 recite allowable subject matter.

III. REJECTIONS UNDER 35 U.S.C. §103

Claims 1, 2, 4, 6, 8, 10, 29-32, 34, 36 and 38-42 were rejected under 35 U.S.C. §103(a) as allegedly as allegedly unpatentable over U.S. Patent No. 6,263,023 to Ngai in view of U.S. Patent No. 5,623,615 to Salem and further in view of U.S. Patent No. 6,848,117 to Emura;

Claims 5 and 33 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Ngai and Salem further in view of U.S. Patent No. 5,532,744 to Akiwumi-Assani et al. (hereinafter, merely “Akiwumi-Assani”);

Claims 9 and 37 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Ngai and Salem and further in view of U.S. Patent No. 5,510,842 to Phillips et al. (hereinafter, merely “Phillips”); and

Claims 3 was rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Ngai in view of Salem and further in view of Official Notice.

Applicant respectfully traverses these rejections for at least two reasons.

A. THE CITED REFERENCES DO NOT
TEACH OR SUGGEST EACH AND EVERY
ELEMENT RECITED IN THE CLAIMS

Independent claim 1, as amended, recites, *inter alia*:

“wherein said plurality of decoding means output an end signal indicating completion of decoding to said selection means, said selection means includes storage means for storing a value corresponding to a processing state of each of said plurality of decoding means such that when values stored in said storage means all become equal to a first value, a value stored therein corresponding to decoding means outputting said end signal indicating completion of decoding is changed from said first value to a second value.”

Claim 1 has been amended to add another element not taught or suggested in any of the references. In particular, claim 1 recites, “wherein said plurality of decoding means output an end signal indicating completion of decoding to said selection means, said selection means includes storage means for storing a value corresponding to a processing state of each of said

plurality of decoding means such that when values stored in said storage means all become equal to a first value, a value stored therein corresponding to decoding means outputting said end signal indicating completion of decoding is changed from said first value to a second value.” Support for this amendment is found throughout the specification as-filed and, for example, in the Publ. Appl. par. [0077] and [0090]; *See, also*, claim 7.

Claim 1 is patentable over the Ngai, Salem, Emura, Akiwumi-Assani and Phillips because those references taken alone or in combination do not teach or suggest each and every limitation recited in the claim.

For reasons similar or somewhat similar to those described above with regard to independent claim 1, independent claim 10 is also believed to be patentable.

B. NO MOTIVATION TO COMBINE THE CITED REFERENCES

As discussed by the Court of Appeals for the Federal Circuit, a proper conclusion of obviousness under 35 U.S.C. 103 requires that there be some motivation in the prior art that suggests the claimed invention as a whole:

“[A]n Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” [Citations omitted] To prevent the use of hindsight based on the invention

to defeat patentability of the invention, this court requires the examiner to show motivation to combine the references that create the case of obviousness.”

In re Rouffet, 149 F.d3 1350, 1357; 47 U.S.P.Q. 2d (BNA) 1453, 1457-1458 (Fed. Cir. 1998).

As further explained by the Federal Circuit:

“Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q. 2d (BNA) 1614, 1617 (Fed. Cir. 1999) “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight.” *Id.*

The Office Action asserts just the sort of hindsight that is impermissible. The Office Action of January 4, 2007, on page 4, states the motivation to combine the teaching of Emura as, “to modify the proposed combination of Ngai and Salem by outputting a picture at an arbitrary playback speed in order to playback data with the characteristics of a stream.”

In the Background of Emura, it states:

“...since the conventional system does not have any means for informing the terminal apparatus of a keyframe playback interval that has been determined for reasons on the video server apparatus side, the terminal apparatus cannot control the keyframe playback interval in accordance with the characteristics of a stream.” Col. 6, lines 20-27.

This is the only location in Emura where “characteristics of a stream” are discussed at all. This is in the Background of Emura and is not a motivation to combine Emura with other inventions. Emura’s disclosure, “the terminal apparatus cannot control . . . in accordance with the characteristics of a stream” is the mere statement of a problem. At best (and Applicant does not concede this point), it is part of Emura’s invention, “to control the keyframe playback interval in accordance with the characteristics of a stream.” There is no suggestion in the Emura

reference to combine Emura's teaching with the combination of Ngai and Salem. Moreover, there is no suggestion in Ngai or Salem to combine their combination with the teaching of Emura.

That is, the Office Action only cites to an object of Emura's invention. The object is, arguably, a purpose for Emura to patent his invention; it is not a motivation to combine Emura with other inventions. There is no motivation that comes from the references themselves to combine with other references. Emura does not seek the teaching of the combination of Salem and Ngai; Salem and Ngai do not seek combination with the teaching of Emura.

It is Applicant's invention to combine the functions recited in the claims. The referenced motivations to combine come from the Applicant's own disclosure not from the cited references. Thus, the motivations to combine cited in the Office Action come from the Applicant's own disclosure. It is the very essence of hindsight to take Applicants invention as a blueprint for finding the stated features and then asserting it would be obvious to make the combination absent some motivation that is in the references.

What is lacking from the combination of the references is a teaching, suggestion or motivation, that comes from the references themselves, or from the problem to be solved, to combine the respective teachings to arrive at the applicants' claimed invention.

Hence, there is no motivation to combine in the references to combine those references to achieve the Applicants' invention.

IV. DEPENDENT CLAIMS

The other claims are dependent from one of the claims discussed above and are therefore believed patentable for at least the same reasons. Because each dependent claim is also deemed

to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

Claims 1-10 and 29-42 are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

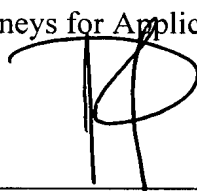
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In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By: _____


Paul A. Levy
Reg. No. 45,748
(212) 588-0800